

REMARKS

Claims 1-24, 27-31, 33, 36, 38-40, 42-43 and 45-66 were pending. Claims 36, 38-40, 42-43, 45-61 and 64 have been withdrawn from consideration. Claims 61 and 64 have been canceled and claims 1, 2, 14, 21-24, 27-31, 33, 43, 57, 62-63 and 65-66 have been amended. Upon entry of the present amendment, claims 1-24, 27-31, 33, 62-63 and 65-66 will remain pending and claims 36, 38-40, 42-43 and 45-60 will remain withdrawn.

Support for the amendments to the claims can be found throughout the specification and claims as originally filed. Exemplary support for amendments is discussed in more detail below. No new matter has been added. Applicants reserve the right to pursue canceled subject matter in one or more continuation or divisional applications.

Election/Restrictions

Applicants note that the Restriction Requirement which issued in the present application does not appear to encompass all of the originally claimed subject matter. For example, compounds where X, Y and Z are all carbon moieties have not been included in a group. Accordingly, Applicants respectfully request a complete listing of groups in view of the possible new continuation rules.

Applicants respectfully request rejoinder of claims 45-60, as they are all dependent from claim 2 and all fall within the scope of elected group IV.

Applicants respectfully reiterate that it is their understanding that, upon finding of an allowable product claim, method claims that depend from or otherwise include all the limitations of an allowable composition claim will be re-joined in accordance with the provisions of MPEP §821.04. Accordingly, Applicants respectfully request rejoinder of the claims of Group II, in pertinent part, should any of the pending composition claims be found to be allowable.

Claim Rejections - 35 U.S.C. §112

Claims 1-20, 21-24, 27-31, 33 and 62-63 have been rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Without acquiescing to the validity of the rejection, and solely in the interest of prosecution, claims 1-20, 21-24, 27-31, 33 and 62-63 have been amended thereby rendering the foregoing rejection moot.

The Examiner has indicated that certain terms, *e.g.*, heteroaliphatic and heteroalicyclic, are vague and indefinite because they need to be defined clearly for how many carbon and heteroatom members are present. Applicants respectfully submit that, in the interest of expediting prosecution, the claims have been amended to add the number of members in the moieties, thereby rendering the rejection moot. Specifically with regard to the number of heteroatoms in certain groups, the term heteroaliphatic and heteroalicyclic are defined in the specification as “aliphatic moieties in which ***one or more carbon atoms in the main chain have been substituted with a heteroatom,***” (emphasis added) and “compounds which combine the properties of heteroaliphatic and cyclic compounds,” respectively. Accordingly, the skilled artisan would understand that, for example, a C1-6 alkyl includes a 6 membered saturated carbon chain wherein one or more (*i.e.*, 1 to 5) carbon atoms have been replaced with a heteroatom.

The Examiner has indicated that the phrase “protecting groups” is indefinite because it needs to be defined for what kind of protecting groups are used in the claims. Applicants respectfully submit that the skilled artisan is readily able to determine suitable protecting groups for use in connection with the present invention. However, in order to expedite prosecution, the claims have been amended to recite specific protecting groups. Support for the amendment to the claims can be found, for example, in paragraph [0180] of the published application.

The Examiner has indicated that the phrase “cyclic ring containing 1 to 4 carbon atoms” is indefinite because the term containing would mean that there are additional substituents present in the ring. Applicants respectfully submit that amendment of the claims to recite “cyclic ring ***of*** 1 to 4 carbon atoms,” has, in pertinent part, rendered the rejection moot.

The Examiner has indicated that the phrase “acceptable derivatives” is indefinite because the specification does not elaborate what is meant by the term. Applicants respectfully disagree and submit that the skilled artisan is readily able to determine acceptable derivatives for use in connection with the present invention, particularly in light of the detailed discussion in the passage at paragraphs [0222]-[0225] of the published application. However, in order to expedite prosecution, the claims have been amended to recite “acceptable salts and esters.” Support for the amendment to the claims can be found, for example, in paragraph [0222] of the published application

In view of the foregoing, Applicants respectfully submit that the rejection of claims 1-20, 21-24, 27-31, 33 and 62-63 under 35 U.S.C. §112 has been rendered moot, and request withdrawal of the rejection and reconsideration of the claims.

Double Patenting

Claims 1-24, 27-31, 33, 62-63 and 65-66 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22, 40, 43, 66 and 81 of co-pending U.S. Application No. 10/507,067.

Pursuant to MPEP 804(I)(B)(1), Applicants respectfully submit that, upon allowance of the present application, a terminal disclaimer will be filed in co-pending U.S. Application No. 10/507,067, thus rendering a nonstatutory obviousness-type double patenting rejection moot.

CONCLUSION

In view of the above amendment, Applicants believe that the pending application is in condition for allowance. The Examiner is invited to contact the undersigned with questions or comments with regard to the present application.

A request for the appropriate extension of time is being filed concurrently herewith. Please charge any additional fees or credit any overpayment to our deposit account, 12-0080, under EISN-018CP, from which the undersigned is authorized to draw.

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Respectfully submitted,

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